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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,930	04/25/2001	Fernando Incertis Carro	FR920000022US1	6591

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IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPT.
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EXAMINER

PESIN, BORIS M

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 11/24/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/841,930

Examiner

Boris Pesin

Applicant(s)

CARRO, FERNANDO INCERTIS

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7, 9-11, 14, 17-20 and 22-24 is/are allowed.
- 6) ☒ Claim(s) 8, 12, 21, 25, 26, 27 is/are rejected.
- 7) ☒ Claim(s) 13, 15, 16, 28, 29, 30 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

1. The use of the trademark Unix, Dos, Windows, Macintosh (page 1, Line 18), and Archie, Gopher, and WAIS (page 2, line 6) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

<http://www.microtouch.com/> (page 20, line 3) must be removed from the specification.

<http://www.universaldisplay.com/toled.html> (Page 21, Line 12), must be removed from the specification.

All other hyperlinks on pages 27-28 must be removed from the specification.

All hyperlinks on page 34 must be removed.

3. The disclosure is objected to because of the following informalities:

There is an extra comma present on page 31, line 6. "(bar code reader . . .),,"

There is a strange character on page 33, line 26, in the word user. The "r" seems to have strange shading to it.

"TouchTeck4" is misspelled on page 20 Line 2.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 8, 21, 12, and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In regards to claim 8 and 21, the inventor discloses that a physical document can be a hard copy document or any type of physical surface such as an engraved, printed, painted, written surface, of any material such as paper, wood, plastic and of any for such as a newspaper, magazine, book, catalog, geographical map, photograph and a map. However in the independent claims 1, and 16, that claims 8 and 21 correspond to it is disclosed that light will be able to visualize the hyperlinked items on the physical document. It is not clear to the examiner how putting something on top (as per the

specification) such as a piece of wood or a piece of plastic would allow light to shine through the material to allow the user to actually see what is hyperlinked.

In regards to claims 12 and 25, it is not clear to the examiner what the functions of claim 12 and 25 are, and how they further narrow the limitations of their respective independent claims.

Since the examiner cannot fully comprehend claims 8, 21, 12, and 25, they will not be treated on merits in this office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Regarding claims 8 and 21, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

6. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The inventor discloses "a user system according to the preceding claim", however there is no mention of which preceding claim the inventor is referring to.

The examiner recommends that this claim be rewritten in an independent form because currently the claims are written in the form of a preamble made to depend on another claim. The stated preamble is not given patentable weight as it fails to breathe

life, meaning, and vitality into the claims. As such, the claims fail to further limit the subject matter of the claim(s) upon which they depend. See MPEP §§ 608.01(n) and 2111.02.

Because claim 26 is vague and indefinite, claim 26 and 27 have not been treated on their merits.

Regarding claim 25, the word "means" is preceded by the word(s) "An user system comprising" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Objections

7. Claim 8 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, claim 8 has not been further treated on the merits.

8. Claim 16 is objected to because of the following informalities:

The word "an" should actually be an "a" in the phrase, "creating an hyperlink table".

Appropriate correction is required.

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9. Claims 12, 13, 15, 25, 26, 28, 29, and 30 are objected to for being in improper dependent form. The claims are written in the form of a preamble made to depend on another claim. The stated preamble is not given patentable weight as it fails to breathe life, meaning, and vitality into the claims. As such, the claims fail to further limit the subject matter of the claim(s) upon which they depend. See MPEP §§ 608.01(n) and 2111.02.

Allowable Subject Matter

10. Claim 1, 2, 3, 4, 5, 6, 7, 9, 10, 11, 14, 17, 18, 19, 20, 22, 23, and 24 are allowed over prior art.

Claims 13, 15, 16, 28, 29, and 30 would be allowable if rewritten to overcome the objections, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 26 and 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Though it is well known in the art to combine a touch screen and a display screen, it is not known in the prior art to combine a touch screen and a transparent display screen in order to highlight specific topics on any physical document, and

provide more information about the highlighted subject matter, when touched, to the user on the user system.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Pesin whose telephone number is (703) 305-8774. The examiner can normally be reached on Monday-Friday except for every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (703) 308-0640. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



STEVEN SAX
PRIMARY EXAMINER

STEVEN SAX
PRIMARY EXAMINER